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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/531,090	04/11/2005	Rami-Raimund Awad	11885-00062-US	2706

23416	7590	11/20/2007
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EXAMINER	
FEELY, MICHAEL J	

ART UNIT	PAPER NUMBER
1796	

MAIL DATE	DELIVERY MODE
11/20/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/531,090

Applicant(s)

AWAD ET AL.

Examiner

Michael J. Feely

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>20050411, 20050613, 20050630</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Pending Claims

Claims 1-13 are pending.

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 112, 2nd paragraph

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are:

The instant claims feature component ABC, which is described as both "a resin" and "an adduct mixture". In light of this, it is unclear if ABC is a reaction product formed by the co-reaction of components A, B, and C; or if ABC is a mixture of reaction products AC and BC. The specification fails to clarify this as well.

4. Claims 2, 3, 6, 7, 9, and 11 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission

amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are:

The instant claims feature component DEF. It is unclear if DEF is a reaction product formed by the co-reaction of components D, E, and F; or if DEF is a mixture of reaction products DE and DF.

5. Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Parent claim 2 discloses unsaturated urethanes DEF are derived from components D, E, and F; however, claim 9 recites that component E is optional in the formation of unsaturated urethanes DEF. Accordingly, it is unclear what is required to form the unsaturated urethanes DEF.

6. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 8 sets forth a process, wherein an epoxy resin A modified by polyethylene glycol is prepared by reacting *the hydroxyl compound on which the epoxy resin is based* with *the diepoxide on which the epoxy resin is based* in the way of an advancement reaction. It is unclear what *the hydroxyl compound* is referring to: the polyethylene glycol or some other hydroxy compound.

Claim Rejections - 35 USC § 112, 1st paragraph

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 1-13 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The structural relationship of component ABC is critical or essential to the practice of the invention, but not included in the claim(s). Such an omission is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

The instant claims feature component ABC, which is described as both "a resin" and "an adduct mixture". In light of this, it is unclear if ABC is a reaction product formed by the co-reaction of components A, B, and C; or if ABC is a mixture of reaction products AC and BC. The specification fails to clarify this as well.

9. Claims 2, 3, 6, 7, 9, and 11 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The structural relationship of component DEF is critical or essential to the practice of the invention, but not included in the claim(s). Such an omission is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

The instant claims feature component DEF. It is unclear if DEF is a reaction product formed by the co-reaction of components D, E, and F; or if DEF is a mixture of reaction products DE and DF.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Budde et al. (US Pat. No. 5,629,374).

Regarding claim 1, Budde et al. disclose: *(1)* an aqueous curable binder comprising non-ionically stabilized epoxy resins (claims 1 & 9), characterized in that comprise building blocks of epoxy resins (claim 1 & 9) and of olefinically unsaturated acids C (claims 1 & 9), and that at least 50% of all reaction products derived from epoxy resins comprise at least one ester group formed by the reaction of a terminal epoxy groups with an olefinically unsaturated acid C (column 5, lines 6-16).

Budde et al. do not explicitly disclose the use of epoxy resins A modified with polyethylene glycol and epoxy resins B that are free from ethylene glycol groups. Rather they contemplate a mixture of epoxy resins selected from a list featuring the diglycidyl ether of polyethylene glycol and multiple epoxy resins free from ethylene glycol groups (*see claims 1 & 9*). Based upon this disclosure and the size of the claimed list, it would have been obvious to one of ordinary skill in the art at the time of the invention to use the instantly claimed combination of epoxy resins.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use the instantly claimed combination of epoxy resins in the preparation of the modified epoxy resin of Budde et al. because Budde et al. contemplate a mixture of epoxy resins selected from a list featuring the diglycidyl ether of polyethylene glycol and multiple epoxy resins free from ethylene glycol groups.

Communication

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Feely whose telephone number is 571-272-1086. The examiner can normally be reached on M-F 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Michael J. Feely
Primary Examiner
Art Unit 1796

November 16, 2007

MICHAEL FEELY
PRIMARY EXAMINER